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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,548	09/10/2003	Nobuyuki Saruya	S0530.0005	3244
32172	7590	10/04/2005		
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			EXAMINER LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/658,548

Applicant(s)

SARUYA, NOBUYUKI

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 10-37 is/are rejected.
- 7) ☒ Claim(s) 5-9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 9/10/03 & 5/7/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Objections

1. Claims 1, 2 and 4-9 are objected to because of the following informalities:
 - a. in claim 1, line 13, “an” before “detachable” should be --a--; line 16, --a-- should be inserted between “includes” and “positioning”
 - b. in claim 2, line 15, “an” before “detachable” should be --a--; line 18 --a-- should be inserted between “includes” and “positioning”
 - c. in claims 4-9, recitation that the “scope unit includes the insertion portion” is redundant (note claims 1 and 2 recite that the scope unit comprises the insertion portion)Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1 and 2, term “fixed connector side” lacks antecedent basis. In addition, phrase “for positioning a connected position” is ambiguous as to what exactly is being “positioned”.

As to claim 8, term “angle driving section” lacks antecedent basis. It appears that this claim should have been dependent on claim 3.

As to claims 10-17 and 24-31, term “positioning means” lacks antecedent basis. It appears that this should be --positioning section--.

As to claims 21 and 35, phrase “wherein a plurality of different types of scope units are disposed beforehand” is ambiguous as to the intended scope. Is this attempting to claim additional scope units in the combination?

Dependent claims inherit those defects.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3, 10-15, 18, 19, 22-29, 32, 33, 36 and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Danna et al. (U.S. Pat. 4,539,586).

As to claims 1-3, Danna et al. disclose a scope unit including an insertion section (18,22,26), an observation unit (col.2, lines 42-45) in a tip end of the insertion section, a curved portion and angle driving section which bends the tip (col.2, lines 40-46) and a base unit (20) connected to a base end of the insertion portion, and a fixed unit (17) to which the base unit is detachably connected. The base unit (Fig.3) includes a movable connector (76,77,81, Fig.3, col.4, lines 10-38) on a detachable portion (left hand side of Figure 3). Any of the elements that project from the detachable portion and connect with the connector on the fixed unit (Fig.4) can

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be considered a “positioning section for positioning a connected position of the fixed connector side to the base unit side”, as broadly and vaguely as claimed. As to claim 10 and 12, any of the projections (e.g., 30, 35, Fig.3) provides a “convex” portion which fits with any of the recesses (e.g. 31,36, Fig.4), which provides a “concave” portion. As to claim 11, note stepwise taper (85,87, Fig.5) or taper in bore (31, Fig.5) and the either (76) or (30), respectively, which fits into these fitting holes. As to claims 13-15, note two convex portions (35) on upper and lower sides that are “high by one step” and two concave portions (36) on upper and lower sides that are “low by one step”. As to claims 18 and 19, note optical (76) and electrical (40) connectors. As to claims 22 and 23, note (30) and (31). As to claims 24-29, 32, 33, 36 and 37, note discussion of claims 10-15, 18, 19, 22 and 23.

6. Claims 1-4, 10, 12-15, 18, 19, 24, 26-29, 32 and 33 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Motoki et al. (US 2004/0133075).

Note Figure 2B and paragraphs [0091] to [0111].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claims 16, 17, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danna et al.

Danna et al. disclose the connector as described above including guide projections (35) and guide recesses (36) in the shape of flat plate. Hence, Danna et al. fails to disclose all particular shapes and number of guides that can be used for providing the same purpose (e.g., four L-shaped guides, annular guide, etc.). Since there is no criticality as to the shape or number of guides/recesses that could be used with no apparent difference in function or purpose, one of ordinary skill in the art at the time of the invention would have considered any shape or number of guides/recesses obvious as a mere matter of design consideration. A change in the shape of a prior art device is a design consideration within the skill of the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

9. Claims 20, 21, 34 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Danna et al. in view of Dowdy et al. (U.S. Pat. 6,295,082).

In the Danna et al. device, circuitry (Fig.8) is provided in the base unit to allow the user to make adjustments (using variable resistors) in driving and output signals from and to the processor to accommodate differences in the characteristics of imaging devices from one scope to another (col.5, lines 18-60). Thus, Danna et al. fail to disclose a first control circuit in the base unit for storing information and a second control circuit in the fixed unit for reading such information. However, Dowdy et al. shows that it is known to provide a first control circuit (storage device 28) for storing information in the base unit (note location of 28 in Fig.1) and a second control circuit (MPU 48) in the fixed unit (Fig.1) for reading such information. The

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Dowdy et al. arrangement allows for automatic adjustment of performance characteristics to optimize processor conversion of the image (col.1, line 60 to col.2, line 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided a first control circuit in the base unit of Danna et al. for storing information and a second control circuit in the fixed unit for reading such information. The inclusion of such would allow for automatic adjustments and allow more than just serial clock, parallel clock and gain adjustments to be made (a storage device can store countless amounts of information that could be used to further optimize the operation of the Danna et al. device). Therefore, the claim limitations of claims 21 and 35 are met.

Regarding claims 20 and 34, and in using the arrangement of Dowdy et al., the MPU (48) detects the connection of the endoscope to the processor and responds by downloading the information from the storage device (28). This would provide a connection detection means. Since no specific mechanical structure is disclosed, it is assumed that the detection is done through the electrical connection, which happens to be pins in the Danna et al. device (note 41, Fig.4).

Allowable Subject Matter

10. Claims 5-9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Conclusion

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11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Takami (U.S. Pat. 6,348,035)

Fujikawa et al. (US 2004/0158128)

Murata et al. (U.S. Pat. 6,652,451)

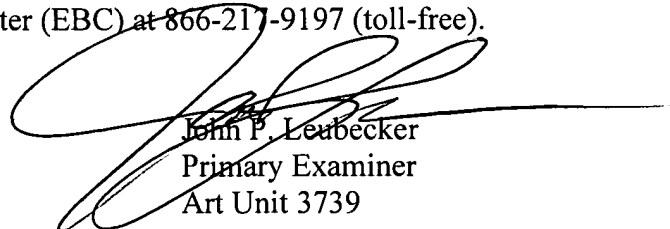
Enomoto et al. (U.S. Pat. 5, 967,969)

Rovegno (U.S. Pat. 6,315,712)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl